

### **REMARKS**

Claims 1-12 and 15 are pending in the present application. Claims 11 and 15 were amended. Entry of the amendment is requested as no new issues have been presented by virtue of the amendment that would require further search and consideration. Reconsideration of the claim rejections is respectfully requested in view of the following remarks.

#### **Claim Rejections – 35 U.S.C § 112**

Claim 11 stands rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in para. 3 and 4 of the Office Action. Claim 11 has been amended to address the rejection. Accordingly, withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

#### **Claim Rejections – 35 U.S.C § 101**

Claim 15 stands rejected under 25 U.S.C § 101, for the reasons set forth in para. 4 and 5 of the Office Action. Specifically, the Examiner states that “the claim still fails to positively recite the act of executing the steps of the method to generate a useful concrete and tangible result”.

Applicants respectfully disagree. It should be noted at the outset that claim 15 has been amended to correct a typographical error. In any event, claim 15 does not need to positively recite the act of executing the steps of a method, because claim 15 does not recite a method, but rather a program storage device having a program of instructions. As noted in MPEP 2106.01, “[w]hen functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” and “functional descriptive material” consists of

data structures and computer programs which impart functionality when employed as a computer component". Since claim 15 recites functional descriptive matter (i.e., a program of instructions executable by a machine to perform method steps of generating an index for a sequence that supports a non-contiguous subsequence match) recorded on some computer-readable medium (i.e., the program of instructions are tangibly embodied on a program storage device executable by a machine), claim 15 recites valid statutory subject matter, and produces a useful, concrete, and tangible result. Accordingly, withdrawal of the rejection under 35 U.S.C. § 101, is respectfully requested.

**Claim Rejections – 35 U.S.C §102(a)**

Claims 1-12, and 15 stand rejected under 35 U.S.C §102(a) as being anticipated by the article entitled, "Indexing Weighted-Sequences in Large Databases". Applicants had previously submitted an affidavit under 37 CFR 1.132 to prove that a graduate student, Sanghyun Park, is not an inventor of the claimed inventions. The Examiner states in para. 2 of the Office Action, that the affidavit is insufficient because the evidence of record contains contradictory information. Specifically, the Examiner states the following:

"The listing of the graduate students' name suggests inventive contribution, yet the declaration indicates no inventive contribution by the student. This contradiction leads to a conclusion of insufficient evidence, although this might be resolved by providing more information from the graduate student as to the degree and nature of the contribution."

Applicants respectfully disagree because under MPEP 716.10, "the designation of authorship does not raise a presumption of inventorship..." Therefore, the listing of the graduate students' name on the article does not suggest inventive contribution, nor can it be considered evidence of contradictory evidence. Indeed, MPEP 716.10 provides an example of contradictory evidence where the non-applicant author submitted a letter

declaring the author's inventorship. See *Ex parte Kroger*, 218 USPQ 370 (Bd. App. 1982). However, there is no evidence here if any such letter or equivalent contradictory information.

MPEP 716.10 states "that it is incumbent upon the inventors named in the application... to provide a 1.132 affidavit to rebut a rejection under 35 U.S.C 102(a)... to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author..." Further, MPEP 715.01(c) states that "[a]n affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). Since such an affidavit was previously provided and no evidence exists to the contrary, applicants have satisfied their burden and the 102(a) rejection has been rebutted. This is further supported by MPEP 716.10 which additionally states that "[a]n uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. See *In re DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982). The previously provided affidavit includes the following statement:

"The subject matter of the article describes solely our own work. While Sanghyun Park is listed as a co-author of the article, he made no inventive contribution to the subject matter in the article..."


Since the above statement is an uncontradicted unequivocal statement from applicants regarding the subject matter disclosed in the article, it must be accepted as establishing inventorship.

Accordingly, at least for the foregoing reasons, withdrawal of the rejection under 35 U.S.C. § 102(a), is respectfully requested.

In view of the foregoing remarks, it is respectfully submitted that all the claims now pending in the application are in condition for allowance. Early and favorable reconsideration is respectfully requested.

Respectfully submitted,

By:



Frank V. DeRosa

Reg. No. 43,584

Attorney for Applicants

F. Chau & Associates, LLC  
130 Woodbury Road  
Woodbury, New York 11797  
TEL: (516) 692-8888  
FAX: (516) 692-8889